

Application No.: 10/800,024
Filed: March 12, 2004

REMARKS/ARGUMENTS

The Examiner imposed a restriction requirement and/or election as follows:

- I. Claims 1-8, 25-32, 49, 50 and 55, drawn to a composition comprising a protein crystal of a HSD11B1 with at least 90% identity to amino acids 24-292 of SEQ ID No: 1, methods of making therefor, and a composition of the isolated protein thereof consisted of amino acids 24-292 of SEQ ID No: 1 or with a His-tag (SEQ ID No: 5), classified in class 435, subclass 183.
- II. Claims 9-16, 33-40, 51, 52 and 56, drawn to a composition comprising a protein crystal of a HSD11B1 with at least 90% identity to amino acids 24-258 of SEQ ID No: 1, methods of making therefor, and a composition of the isolated protein thereof consisting of amino acids 24-268 of SEQ ID No: 1 or with a His-tag (SEQ ID No: 6), classified in class 435, subclass 183.
- III. Claims 17-24, 41-48, 53, 54 and 57, drawn to a composition comprising a protein crystal of a HSD11B1 with at least 90% identity to amino acids 24-267 of SEQ ID No: 1, methods of making therefore, and a composition of the isolated protein thereof consisting of amino acids 24-267 of SEQ ID No: 1 or with a His-tag (SEQ ID No: 7), classified in class 435, subclass 183.
- IV. Claims 58-64, drawn to methods of performing rational drug design based on the 3-D coordinates obtained from the crystal having at least 90% identity to amino acids 24-292 of SEQ ID No: 1, classified in class 703, subclass 11.
- V. Claims 65-71, drawn to methods of performing rational drug design based on the 3-D coordinates obtained from the crystal having at least 90% identity to amino acids 24-258 of SEQ ID No: 1, classified in class 703, subclass 11.
- VI. Claims 72-78, drawn to methods of performing rational drug design based on the 3-D coordinates obtained from the crystal having at least 90% identity to amino acids 24-267 of SEQ ID No: 1, classified in class 703, subclass 11.

I. Claim Amendment

Claims 1, 9, 17, 25, 33, 41, 49-58, 65, and 72 have been amended to correct informalities. Claims 49-57 have been amended for technical clarity. No new matter has been added due to the amendments and the amendments do not affect the inventorship.

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2. Election in Response to Restriction

Pursuant to 37 C.F.R. § 1.142, Applicants hereby elect Group I (1-8, 25-32, 49, 50 and 55) with traverse. Claims 9-24, 33-48, and 51-78 are withdrawn as being directed to non-elected subject matter pursuant to 37 C.F.R. § 1.142(b). All of the pending claims now read on the elected subject matter.

In addition, Applicants reserve the right to petition for rejoinder under 37 C.F.R. §1.144 should a search of the group elected fail to reveal prior art related to the subject matter of the claims. Applicants further reserve the right to rejoinder of restricted claims, such as product and method of use claims, under M.P.E.P. §821.04.

Applicants also reserve the right pursuant to 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected subject matter during the pendency of the present application. Finally, Applicants note the right to petition the restriction under 37 C.F.R. §1.181 upon a request for consideration if the restriction is made final.

3. Traversal of Examiner's Restriction

Applicants traverse the Examiner's six-way restriction of the application on the grounds that the basis for restriction pursuant to M.P.E.P. §803 has not been met.

An application may properly be required to be restricted to one of two or more claimed inventions **only if:**

1. the inventions are independent or distinct as claimed; **and**
2. the search and examination of the entire application places a serious burden on the examiner.

M.P.E.P. §803.

Restriction is only proper when both conditions are satisfied.

Applicants traverse the Examiner's restriction because the inventions are not distinct, and search and examination of the entire application does not place a serious burden on the Examiner.

A. Independent Claims I

In the present application, each of Groups I and IV of restricted claims specifically relate to a protein consists of residues 24-292 of SEQ ID NO:1; each of Groups II and V of restricted claims

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specifically relate to a protein consists of residues 24-258 of SEQ ID NO:1; and each of Groups III and VI of restricted claims specifically relate to a protein consists of residues 24-267 of SEQ ID NO:1

Claims are independent and can be subject to restriction when there is no disclosed relation between the claimed inventions. M.P.E.P. § 806. In this instance, there is a clear relationship between all of the different restricted groups, specifically the feature that the subject protein consists of residues 24-292 of SEQ ID NO:1 in Group I and IV, the feature that the subject protein consists of residues 24-2958 of SEQ ID NO:1 in Group I and IV, and the feature that the subject protein consists of residues 24-267 of SEQ ID NO:1 in Group I and IV. With regard to independent claims 1, 25, and 58 of Group I and IV the claims specifically recited a protein “consists of residues 24-292 of SEQ ID NO:1;” with regard to independent claims 9, 33, and 66 of Group II and V, the claims specifically recited a protein “consists of residues 24-258 of SEQ ID NO:1; and with regard to independent claims 17, 41, and 72 of Group III and VI, the claims specifically recited a protein “consists of residues 24-267 of SEQ ID NO:1.

Further, all of the claims recites overlapping residues of SEQ ID NO:1, with or without His-tag (residues 24-292 for Groups I and IV, residues 24-267 for Groups II and V, and residues 24-258 for Groups III and VI).

B. Request for Reconsideration

In view of the common thread running through the elected and non-elected claims, Applicants submit that the claims of Groups I to VI are not independent or distinct and examination of the entire application does not place a serious burden on the examiner. Accordingly, examination of Groups I to VI without restriction is appropriate and the restriction requirement should be withdrawn. At a minimum, as Groups I-III are classified as the same class and subclass, as are Groups IV-VI, the Applicants could accept a 2-way restriction. Finally, Applicants submit that the rejoinder is appropriate, following allowance of the elected claims, should this restriction not be withdrawn.

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In view of the foregoing, it is believed that all claims now pending in this application are in condition for allowance. Should the Examiner not agree, the Applicants respectfully ask the Examiner to contact the undersigned at 415-442-1000 to discuss any remaining issues and accelerate the examination and allowance of this application, Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (Client Matter No. 067450-5024US).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

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